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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,023	11/13/2001	Raymond F. Cracauer	FORS-06679	3272

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EXAMINER
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HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 10/17/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/054,023

Applicant(s)

CRACAUER ET AL.

Examiner

Dwayne K Handy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2, applicant has claimed a method, but set forth no steps aside from channeling air. Therefore, it is unclear to the Examiner what is required to meet this limitation. In claim 11, applicant has claimed a synthesizer comprised of a "ventilated workspace". Since applicant has not claimed any structural elements which define the synthesizer, this is also unclear. What structure is required to meet the limitation of a synthesizer in a workspace?

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 2-4, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Takagi (3,986,835). Takagi teaches a device with a number of vials (Figures 15 and 16) contained in a vented hood (Figure 17).

4. Claims 1, 2, 4 and 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by DeWitt et al. (5,702,672). Dewitt teaches an apparatus for multiple simultaneous synthesis of compounds. The embodiment most relevant to the instant device is shown in Figures 1 and 4 and includes a base plate (15) with openings, a top enclosure (manifold – 20) with a ventilation opening (one of ports labeled 23) which sits on the base plate and encloses the reaction wells of the device. DeWitt teaches a transparent manifold (20) for monitoring the reactions within the block in column 9, lines 60-65. As to the limitation of claim 1 stating “wherein in an open position, said lid provides a substantially enclosed ventilated workspace”, the Examiner believes the placement of the manifold (20) over the reservoir block (15) without sealing the device would constitute an “open position” while still allowing for the addition or removal of gas from the block.

5. Claims 1, 2, 4, 11-16, and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by McGowan et al. (6,238,627). McGowan teaches a reaction block and cover. The device is shown in Figures 2 and 3 and described in columns 3 and 4. The block contains a base (16) with support holes (18) for holding reaction vials (12). Covering the block is a two-piece cover assembly comprised of a top cover (22) with

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four side walls (26) and a top enclosure (30). The top enclosure contains a hole for a gas tube (32).

6. Claims 2-4, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Freitag et al. (6,485,692). Freitag shows a parallel reaction system. The reaction system includes a hood system which is shown in Figure 19 and described in column 14, lines 52-67.

#### ***Inventorship***

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 5, 6, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGowan (6,238,627) or DeWitt (5,702,672). McGowan and DeWitt, as described above, teach every element of claims 7 and 8 except for a plurality of synthesizers with a reaction chamber and a lid. Both McGowan and DeWitt teach only single reaction blocks. It would have been obvious to one of ordinary skill in the art, however, to provide a plurality of block in a reaction system. The use of a plurality of blocks would provide for the increased production of product.

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi (3,986,835) or Freitag et al. (6,485,692). Takagi and Freitag, as described above, teach every element of claims 7 and 8 except for a plurality of devices with a synthesizer and a vent hood. Both Takagi and Freitag teach only single synthesizer/hood devices. It would have been obvious to one of ordinary skill in the art,

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however, to provide a plurality of synthesizers with hoods. The use of a plurality of synthesizers with hoods would provide for the increased production of product.

11. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGowan (6,238,627) in view of Heyneker et al. (6,264,891). McGowan, as described above, teaches every element of claims 19 and 20 except for a centralized vacuum system. Heyneker also teaches an enclosed reaction system. The system is shown in Figure 1 and includes a vacuum system for drawing fluids from the system. The vacuum system is described in column 10, lines 54-67. It would have been obvious to one of ordinary skill in the art to combine the vacuum system of Heyneker et al. with the block of McGowan. One would add the vacuum system of Heyneker in order to use a vacuum to remove fluids from the system.

12. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGowan (6,238,627) in view of Garran (5,099,988). McGowan, as described above, teaches every element of claims 23 except for printed instructions for assembling the device. Garran teaches a decorative crib that requires assembly before using. Garran's device also includes printed instructions for assembling the device (claim 3). It would have been obvious to one of ordinary skill in the art to combine the teaching of supplying printed instructions with a device to be assembled from Garran with the device of McGowan. One would include printed instructions for assembly to assist in assembly of the device.

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**Conclusion**


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lam (5,651,943), Mohan et al. (6,274,091), Zhou et al. (6,309,608) and Levin et al. (6,432,365) also show examples of enclosed reaction systems with ventilation elements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (703)-305-0211. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703)-308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

Dkh  
September 30, 2003

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700